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10/763,335	01/26/2004	Hideo Kuboyama	00862.023413.	7510
5514 7590 03/04/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SHAH, PARAS D	
			ART UNIT 2626	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/763,335

**Applicant(s)**

KUBOYAMA ET AL.

**Examiner**

Paras Shah

**Art Unit**

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :01/12/2006, 12/15/2006, 1106/2007.

### **DETAILED ACTION**

1. This communication is in response to the Application filed on 01/26/2004. Claims 1-15 are pending and have been examined.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 01/12/2006, 12/15/2006, and 11/06/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13-15 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13-15 are drawn to a "computer program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP 2106.01 [R-5]. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See e.g., Warmerdam, 33 F.3d at 1361, 31, USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between data and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The entire claim is unclear as to what the applicant is intending. Specifically, the limitation "said switching control means makes control that

outputs the synthetic speech generated by said text-to-speech synthesis means to the audio output device, said switching control means further makes control that outputs the text information to the display means." For the purposes of compact prosecution, the limitation was interpreted to mean the switching control means controlling the audio or display units upon switching to perform a specific action.

8. Claims 9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The entire claim is unclear as to what the applicant is intending. Specifically, the limitation "...receiving information used to specify an external apparatus...holding means for holding means for holding list of information used to specify the external apparatus present in a predetermined space." It is unclear in the claim as to what the Applicant is seeking to claim. It is unclear as to what is meant by predetermined space. For the purposes of compact prosecution, the limitations were interpreted to mean the reception of data from an external source and storing the result in storage, where the switching means outputs the data accordingly.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 10, and 13-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Koskan *et al.* (US 6,181,956).

As to claims 1, 10, 13-15, Koskan *et al.* teaches an information service apparatus and method which comprises display means for displaying text information (see Figure 2, display 252), and can be connected to an audio output device that can output speech information corresponding to the text information (see Figure 2, speech synthesizer 260 and Figure 3), comprising:

determination means (see col. 2, lines 65-67, selectable mode switch is used to switch between a visual or audible output and see Figure 4. If the visual model is not selected, the audio version is chosen (see col. 2, lines 40-47 and Figure 4, operating model decision 430).

switching control means (see col. 2, lines 40-47, selectable mode switch is selected by user depending on operating mode) for making output destination switching control that outputs the speech information corresponding to the text information to the audio output device when said determination means determines that the audio output device is connected (see col. 3, lines 62-40, audible version is output if the second operating mode is chosen. This occurs from the selection of the output mode by the user. Hence, the earpiece is connected once the appropriate selection is made.), and outputs the text information to the display means when said determination means determines that the audio output device is not connected (see col. 3, lines 23-31, text is output in

readable form when the switch has been selected to the first operating mode and see col. 2, lines 65-col. 3, lines 2).

However, Koskan *et al.* does not specifically teach the determining if the audio output device is connected.

Hagimoto *et al.* does teach the determination if an audio output device is connected (see [0024], when the plug of the earphone is connected the switch turns on to output voice.).

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have modified the information service method and apparatus as taught by Koskan *et al.* with the inclusion of determining if a earphone is attached as taught by Hagimoto *et al.* The motivation to have combined the references involves detection of external devices to a system (see Hagimoto, [0024])) and switching between visual and voice modes (see Hagimoto, [0012]-[0013]) for handicapped individuals (see Hagimoto, [0006]).

As to claim 2, Koskan *et al.* in view of Hagimoto *et al.* teaches all of the limitations as in claim 1, above.

Furthermore, Koskan *et al.* teaches exchange means (see col. 2, lines 15-25, information received via a wireless link from a remote transmitter.) for exchanging information with an external apparatus via a network, and in that the text information (see col. 2, lines 23, alphanumeric text messages) is information which is received by the exchange means from the external apparatus via the



network (see col. 2, lines 15-19, wireless transmitter sends communication from which the user receives information), and the information includes mail information and Web information (see col. 1, lines 15-18 and col. 2, lines 23) (e.g. Alphanumeric messages consist of any textual message such as emails and information from various other sources.)

As to claim 3, Koskan *et al.* in view of Hagimoto *et al.* teaches all of the limitations as in claim 1, above.

Furthermore, Koskan *et al.* teaches text-to-speech synthesis (see Figure 2, speech synthesizer 260) means for executing a text-to-speech synthesis process on the basis of the text information to generate synthetic speech as the speech information (see col. 3, lines 9-12, text message converted to audible form).

As to claim 4, Koskan *et al.* in view of Hagimoto *et al.* teaches all of the limitations as in claim 3, above.

Furthermore, Koskan *et al.* teaches notification means (see Figure 4, issue alert 435, 455) for, when the synthetic speech generated by said text-to-speech synthesis means is to be output to the audio output device (See Figure 455, message in audible form ) or when the text information is to be output to the display means (see Figure 4, issue alert 435), notifying the user of an output in a corresponding case (see col. 3, lines 25-28 and lines 35-37) (e.g. An alert is sent

to the user if being presented in a visual form. The alert in the audible sense is the audible message, which tells the user the text message is being read).

As to claim 6, Koskan *et al.* in view of Hagimoto *et al.* teaches all of the limitations as in claim 3, above.

Furthermore, Koskan *et al.* teaches wherein when said switching control means see col. 2, lines 40-47, selectable mode switch is selected by user (depending on operating mode) makes control that outputs the synthetic speech generated by said text-to-speech synthesis means to the audio output device (see col. 2, lines 45-52, depending on the switch determination, if audio is selected the control sends a signal to the synthesizer for audible output.), said switching control means further makes control that outputs the text information to the display means (see col. 2, lines 33-37 and 43-45, depending on the switch determination, if display is selected the control sends a signal to display for readable output.).

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koskan *et al.* in view of Hagimoto *et al.* as applied to claim 3 above, and further in view of Toshiyuki (JP 2001236205).

As to claim 5, Koskan *et al.* in view of Hagimoto *et al.* teaches all of the limitations as in claim 3, above.

However, Koskan *et al.* in view of Hagimoto *et al.* do not specifically teach the superimposing means.

Toshiyuki does teach the superposing means for superposing the synthetic speech generated by said text-to-speech synthesis means and a sound different from the synthetic speech (see Abstract) (e.g. When an email is received, it is synthesized into speech and the music which was being output is integrated for output.), and

in that when the audio output device has already output a sound, said superposing means superposes the synthetic speech with the sound, and the audio output device outputs the sound superposed with the synthetic speech (see Abstract) (e.g. The music already output when an email is received. For output, the integration of the text and music is performed.)

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have modified the information service method and apparatus as taught by Koskan *et al.* in view of Hagimoto *et al.* with the inclusion of a superposing means as taught by Toshiyuki. The motivation to have combined the references involves outputting multiple signals without interruption from other signals (see Toshiyuki, "Problem to be solved").

12. Claim 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shojima (US 6,259,990) in view of Koskan *et al.*

As to claims 7 and 11, Shojima *et al.* teaches an apparatus and method an information service apparatus which comprises display means for displaying text information (see Figure 2, display 252), text-to-speech synthesis means for executing a text-to-speech synthesis process on the basis of the text information to generate synthetic speech, and audio output means (see Figure 3, speaker 214) that can output the synthetic speech information (see col. 8, line s 41-43, speech synthesis), comprising:

reception means (see col. 7, lines 1-23, sensors 205 and 206) for receiving information indicating a type of space (e.g. depending on the information picked up by the sensors corresponding information is either audibly or visually output.) ;

determination means (see col. 7, lines medium translation table 154 and use status of activity 154, lines 1-25) for determining a type of space indicated by the information with reference to the information received by said reception means (see col. 7, lines 1-23) (e.g. From the cited portion, the appropriate output is performed based on the levels of activity detected by the sensors.)

However, Shojima *et al.* does not specifically teach switching control means.

Koskan *et al.* does teach switching control means (see col. 2, lines 40-47, selectable mode switch is selected by user depending on operating mode) for making output destination switching control that outputs the synthetic speech generated by the text-to-speech synthesis means to the audio output means (see

col. 3, lines 62-40, audible version is output if the second operating mode is chosen. This occurs from the selection of the output mode by the user. Hence, the earpiece is connected once the appropriate selection is made.), or outputs the text information to the display means (see col. 3, lines 23-31, text is output in readable form when the switch has been selected to the first operating mode and see col. 2, lines 65-col. 3, lines 2), in accordance with a determination result of said determination means.

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have modified the information service method and apparatus as taught by Shojima *et al.* with the inclusion of switching means as taught by Koskan *et al.* The motivation to have combined the references involves the ability to deliver messages when a user may not be able to access and retrieve the communication (see Koskan *et al.* col. 1, lines 24-33).

As to claim 8, Shojima *et al.* in view of Koskan *et al.* teaches all of the limitations as in claim 7, above.

Furthermore, Shojima *et al.* teaches wherein said determination means (see col. 7, lines medium translation table 154 and use status of activity 154, lines 1-25) determines whether the type of space indicated by the information is a private or public space (see col. 7, lines 1-23, sensors 205 and 206 and col. 6, lines 24-31) (e.g. Depending on the information picked up by the sensors corresponding information is either audibly or visually output. Further, it is also

pointed out in the cited portion that to prevent disturbance, which may be a public space then visual information is presented to the user. It is further made obvious from the cited section that private place would entail quietness and audible information is output (see col. 7, lines 20-24, example of outputting based on noise level. A high noise level indicates public space, whereas a low noise level indicates a private space), and

Furthermore, Koskan *et al.* teaches said switching control means (see col. 2, lines 40-47, selectable mode switch is selected by user depending on operating mode) for making output destination switching control that outputs the synthetic speech generated by the text-to-speech synthesis means to the audio output means (see col. 3, lines 62-40, audible version is output if the second operating mode is chosen. This occurs from the selection of the output mode by the user. Hence, the earpiece is connected once the appropriate selection is made.), or outputs the text information to the display means (see col. 3, lines 23-31, text is output in readable form when the switch has been selected to the first operating mode and see col. 2, lines 65-col. 3, lines 2), in accordance with a determination result of said determination means.

The combination of the two references would have enable one skilled in the art at the time the invention was made to provide a switching mechanism based on the noise level or light level using the switching as described in Koskan *et al.* in order to prevent the disturbance of others (see Shojima col. 6, liens 25-30)

13. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koskan *et al.* in view of Shojima (US 6,259,990).

As to claims 9 and 12, Koskan teaches an information service apparatus and method which comprises display means for displaying text information (see Figure 2, display 252), and text –to-speech synthesis means for executing a text-to-speech synthesis process on the basis of text information to generate synthetic , and audio output means that can output the synthetic speech comprising, (see Figure 2, speech synthesizer 260 and Figure 3), comprising:

reception means (see col. 2, lines 19-25, selective call receiver) for receiving information used to specify an external apparatus;

holding means for holding a list of information used to specify the external apparatus present in a predetermined space, and

switching control means (see col. 2, lines 40-47, selectable mode switch is selected by user depending on operating mode) for making output destination switching control that outputs the speech information corresponding to the text information to the audio output device when said determination means determines that the audio output device is connected (see col. 3, lines 62-40, audible version is output if the second operating mode is chosen. This occurs from the selection of the output mode by the user. Hence, the earpiece is connected once the appropriate selection is made.), and outputs the text information to the display means when said determination means determines that

the audio output device is not connected (see col. 3, lines 23-31, text is output in readable form when the switch has been selected to the first operating mode and see col. 2, lines 65-col. 3, lines 2). depending on whether or not the information received by said reception means is included in the list (see col. 2, lines 13-25, information is received from a remote transmitter through wireless radio frequency.).

However, Koskan *et al.* does not specifically teach a holding means.

Shojima *et al.* does teach the use of a holding means for holding a list of information (see col. 4, lines 5-10, recording communication data for storage 202) (e.g. The information relating to guidance is stored for presentation upon access.)

It would have been obvious to one of ordinary skilled in the art at the time the invention was made to have modified the information service method and apparatus as taught by Koskan *et al.* with the inclusion of holding means as taught by Shojima *et al.* The motivation to have combined the references involves the ability to deliver messages when a user may not be able to access and retrieve the communication (see Koskan *et al.* col. 1, lines 24-33).

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Nelson (US 7,013,279) is cited to disclose generation of utterances in response to a selection. Kaneko *et al.* (US 7,120,583) is cited to disclose a text receiving device displaying as well as outputting speech. Xie (US 7,299,182) and Schuller (US 6,965,862) is cited to disclose a ebook. Sakai *et al.* (US 2001/0027395) is cited to disclose a read aloud device outputting text in an audible and visual form. Ohtsuki (US 2002/0006785) is cited to disclose a cellular phone receiving email that outputs speech when folded. Hayashi (US 2002/0026316) is cited to disclose a email device that outputs speech and display information. Hirota (US 2003/0046076) is cited to disclose the superposing of synthesized speech and music. Sakai *et al.* (US 2004/0034528) is cited to disclose receiving information from an apparatus and determining whether it should be output as speech. Sakai *et al.* (US 2005/0119888) and Ikegama (US 2006/0224386) is cited to disclose a GUI module for displaying and synthesizing speech based on selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paras Shah whose telephone number is (571)270-1650. The examiner can normally be reached on MON.-THURS. 7:00a.m.-4:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571)272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/763,335  
Art Unit: 2626

Page 16

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P.S.

02/06/2008

  
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